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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/815,430

03/31/2004

Gregory M. Plow

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INTERNATIONAL BUSINESS MACHINES CORP.

IP LAW

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SAN JOSE, CA 95141

EXAMINER

OSBERG, THUY THANH

ART UNIT

PAPER NUMBER

2179

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/815,430	Applicant(s) PLOW ET AL.	
	Examiner Thuy Osberg	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the original application filed 03/31/2004.

This action is **Non-Final**. Claims 1-39 are pending and have been examined.

Claim Rejections - 35 USC § 101

2. **35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 14-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

As to claim 14, a “computer program usable medium” is being recited; however, as disclosed by the specification sections, the claims are directed to data signal and electromagnetic carrier wave that carries solely the signal, which constitute non-statutory subject matter.

As such, claims 15-26 are rejected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 102

4. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 6-16, 21-29 and 32-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Martinez et al. (US Patent 6,147,683).

The Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the Applicant. Although the specified citations are representation of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. The Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the Applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the Examiner.

As claims 1, 14 and 27, Martinez teaches a method of displaying information (Abstract; fig. 2), comprising:

presenting a **first subset** of information (fig. 3-14, label 127; "List Item 5-26") of a file (col. 5, lines 64-66; fig. 15; col. 8, lines 23-25) in a **scrollable area** (fig. 15, labels 340A-340B; col. 8, lines 21-22), the first subset of information comprising, at least in part, a second subset of information (fig. 5, label "List Item 11"), the **second subset** of information being designated as a materialization entity (col. 6, lines 47-51, that the "List Item 11" is selected as a materialization entity);

and when the file in the scrollable area is scrolled (fig. 6, label 340; col. 6, lines 60-62) and at least a portion of the **materialization entity** is scrolled out of the scrollable area (fig. 6, label 127; col. 6, lines 63-64), displaying the materialization entity, at least in part, in a **materialization area** (fig. 6, label 129B; col. 6, lines 65-67, that the selection marker

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129B that marks the selection of item 11).

The difference between claim 14 to claim 1 is Martinez further teaches a computer program usable medium (fig. 1, labels 130, 155, 195; col. 3, lines 23-27) embodying one or more instructions executable by a computer for performing a method of displaying information (fig. 1, label 126; col. 3, lines 23-27; col.4 lines 27-32).

The difference between claim 27 to claim 1 is Martinez further teaches a processor (fig. 1, label 110; col. 4, lines 27-32) and a memory storing instructions (fig. 1, label 120; col. 4, lines 27-32).

As claims 2, 15 and 28, Martinez further teaches: associating a materialization attribute with the materialization entity to designate the second subset of information as the **materialization entity** (col. 3, lines 2-5; fig. 13-14, labels 129D-F; col. 8, lines 3-7, that the second subset of information is selection markers 129D-F).

As claims 3, 16 and 29, Martinez further teaches the scrollable area is in a **window** (fig. 17, labels 127, 340A-B; col. 8, lines 27-31) and the materialization area is also in that same **window** (fig. 17, labels 129G-H; col. 8, lines 27-31).

As claims 6, 21 and 32, Martinez further teaches the at least a portion of the materialization entity is scrolled out of view (fig. 6, label 127; col. 6, lines 63-64), displaying the materialization area (fig. 6, label 129B; col. 6, lines 65-67, that the

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selection marker 129B that marks the selection of item 11).

As claims 7, 22 and 33, Martinez further teaches:

displaying the materialization area in response to a user activation (col. 6, lines 20-22, lines 30-34; fig. 4, labels 129A, "List Item 7").

As claims 8 and 34, Martinez further teaches when the materialization entity is scrolled back into the scrollable area, **deleting** the materialization window containing the materialization entity (col. 8, lines 53-59, that the materialization area/window (scroll bar) is not required, therefore it is deleted/not shown).

As claims 9, 23 and 35, Martinez further teaches wherein a **third subset** of the information of the file is designated as an additional materialization entity (fig. 10, label 1010; col. 7, lines 34-41);
and when at least a portion of the additional materialization entity is scrolled out of view (fig. 8, label 127, that "List Item 21-25" is selected; fig. 10, label 127, that the selected item list is scrolled out of view), displaying the additional materialization entity (fig. 10, label 1010; col. 7, lines 34-41, at least in part, in the materialization area (col. 5, lines 53-58, that a separate bar or display (second materialization area) is provided for the selection markers 129 (first materialization area);

As claims 10 and 36, Martinez further teaches the materialization entity is **scrolled back** into the scrollable area, deleting the materialization entity from the materialization area (col. 5, lines 59-61, that when the user can view the "List Item" and de-select the materialization, the view must be scrolled back into the scrollable area,

when the user de-selected the selected item, the corresponding marker is removed).

As claims 11, 24 and 37, Martinez further teaches:

in response to a user signal with respect to the materialization entity in the materialization area, **scrolling the file** such that the materialization entity is displayed in the scrollable area (fig. 8; fig. 10, labels 129C, 1010; col. 7, lines 22-27, 34-41).

As claims 12, 25 and 38, Martinez further teaches the materialization entity is associated with a materialization entity designation of temporary, further comprising: when the file is **closed, disassociating** the materialization attribute from the materialization entity (col. 3, lines 56-64; col. 5, lines 62-66, that when the user is done navigating the file of those selected items in the list as well as the marker in the materialization area/scroll bar/attribute are temporary for viewing, therefore, they are disassociated when the file is closed).

As claims 13, 26 and 39, Martinez further teaches the materialization entity is associated with a materialization entity designation of permanent, further comprising when the materialization entity designation is permanent, **storing** the materialization entity designation in **persistent storage** (fig. 13, labels 129D, 129E, 340; col. 8, lines 1-12, that when the user performs a copy of the selected files/materialization entity to another directory/floppy disk, they are stored in the persistent storage).

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-5, 17-20 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez.

As claims 4, 17 and 30, Martinez further teaches the scrollable area is in a first window (fig. 3, labels 127, 320-330; col. 6, lines 5-13; fig. 15, labels 340A-B, col. 8, lines 21-22), and wherein the materialization area is in a second area (fig. 4, label 129A; col. 6, lines 30-34), different from the first window, to provide a materialization window (col. 6, lines 35-38, that the first window displays the selected list items, which will be marked as the selected marker in the scroll bar (materialization area)).

Martinez does not specifically teach the second area is the second window.

However Martinez teaches providing the second area is a separate display portion (window) (fig. 4, label 129A; col. 6, lines 30-34; col. 8, lines 53-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention that such a separate display portion (window) could be a second window to display the graphical elements.

As claims 5, 18 and 31, Martinez further teaches the materialization window is **adjacent** to the first window (fig. 4, labels 127, 340; col. 6, lines 7-13, that the slider 340,

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which contains the selected markers, is adjacent to the window 127).

As claim 19, Martinez further teaches when the materialization entity is scrolled back into the scrollable area, **deleting** the materialization window containing the materialization entity (col. 8, lines 53-59, that the materialization area/window (scroll bar) is not required, therefore it is deleted/not shown).

As claim 20, Martinez further teaches the materialization entity is **scrolled back** into the scrollable area, deleting the materialization entity from the materialization area (col. 5, lines 59-61, that when the user can view the "List Item" and de-select the materialization, the view must be scrolled back into the scrollable area, when the user de-selected the selected item, the corresponding marker is removed).

Conclusion

8. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. 1.111(c) to consider these references fully when responding to this action.

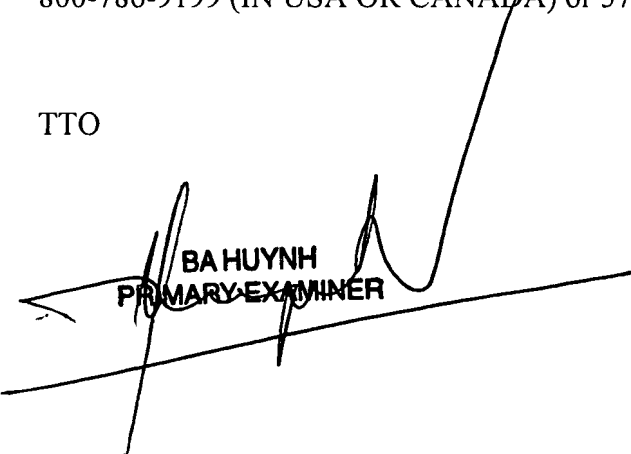
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Osberg whose telephone number is 571-270-1258. The examiner can normally be reached on Monday-Friday (8:30AM-5:00PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TTO


BA HUYNH
PRIMARY EXAMINER